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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,371	10/05/2000	Mari Ichimura	09792909-4647	8232

7590 06/17/2004

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EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/680,371

Applicant(s)

ICHIMURA ET AL.

Examiner

Brian J. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) 31-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 1-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

The examiner acknowledges for the record that applicant has established that the priority document has been submitted.

### ***Claim Objections Withdrawn***

The objection to claims 14-30, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment cancels the claims.

### ***Claim Objections Maintained***

The objection to claims 1-13, outlined in the previous Office Action, is maintained for reasons of record. There remain several instances of claims not ending in a period. The claim must end with a period even if the last "text" appearing in the claim is a structure.

### ***Claim Objections, NEW***

Claims 1-13 are objected to because of the following informalities: there are instances of incorrect spelling, for instance, in the final paragraph of claim 2: "wh re." Other instances are similar. Appropriate correction is required.

Applicant's help is respectfully requested in correcting any other minor spelling and/or grammatical errors present in the claims.

***Double Patenting Rejections Withdrawn***

The rejection of claims 1-30, under the judicially created doctrine of obviousness-type double patenting over claim 5 of US 6,242,116, outlined in the previous Office Action, has been overcome by applicant's submission of a Terminal Disclaimer. Claims 14-30 have been canceled.

The rejection of claims 14-30, under the judicially created doctrine of obviousness-type double patenting over claim 5 of US 6,440,585, outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment cancels claims 14-30.

***Double Patenting Rejections Maintained***

The rejection of claims 1-13, under the judicially created doctrine of obviousness-type double patenting, over claim 5 of US 6,440,585, outlined in the previous Office Action, is maintained for reasons of record. Although applicant states that a Terminal Disclaimer has been submitted, no such disclaimer is of record in the application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. There are instances of inconsistent and therefore unclear changes made to the claims by applicant's amendment. For instance, in claim 2, it is unclear if the aryl group of formula 9 has remains within the metes and bounds of the claim, since the claim teaches "formula (9)," yet the formula is now undefined since the amendment deletes its structure. This inconsistency propagates to claim 3, where substituent R<sup>54</sup> now has no antecedent basis. Other instances are similar.

Applicant's help is respectfully requested in correcting any other inconsistencies and errors introduced into the claims by the amendment.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
June 14, 2004